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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/260,802	03/02/1999	STEVEN M. HOFFBERG	3459-11	6940

7590

10/29/2002

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INTELLECTUAL PROPERTY LAW  
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SUITE 460  
WHITE PLAINS, NY 10606

EXAMINER

GORDON, PAUL P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/260,802

Applicant(s)

Hoffberg et al.

Examiner

Gordon

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 and 66-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 60 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 60, line 4, the phrases, "the degree of content" and "said predetermined characteristics", both lack antecedent basis.

Claims 61-63 also stand rejected based on their dependency of rejected base claims and/or intermediary claims above.

3. Claims 35-65 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The 35 U.S.C. §112, first paragraph rejection in the previous office action is incorporated herein by reference.

4. Claims 35, 40, 47, 55, 58 are rejected under 35 U.S.C. §102(b) as being anticipated by Yourick et al. (4,775,935).

The 35 U.S.C. §102(b) rejection in the previous office action is incorporated herein by reference.

5. Claims 36-39, 48-54, 56, 57, 59-65 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yourick et al. (4,775,935).

The 35 U.S.C. §103(a) rejection in the previous office action is incorporated herein by reference.

6. Claims 35-39, 40-46, and 47-65 of this application have been somewhat copied by the applicant from U. S. Patent No(s): 5,724,567; 5,758,257; and 5,754,939, respectively. These claims are not patentable to the applicant because of the 35 U.S.C. §112, 1st paragraph; the 35 U.S.C. §102(b); and the 35 U.S.C. §103 rejections above.

An interference cannot be initiated since a prerequisite for interference under 37 C.F.R. §1.606 is that the claim(s) be patentable to the applicant subject to a judgement in the interference.

7. Claims 35-39, 40-46, and 47-65 of this application are asserted by applicant to correspond to all claim(s) of U.S. Patent No(s): 5,724,567; 5,758,257; and 5,754,939, respectively.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No(s): 5,724,567; 5,758,257; and 5,754,939 because:

U.S. Patent 5,724,567 invented: A system for directing relevance-ranked data objects to computer users;

U.S. Patent 5,758,257 invented: A system and method for scheduling broadcast of and access to video programs and other data using customer profiles;

U.S. Patent 5,754,939 invented: A system for generation of user profiles for a system for customized electronic identification of desirable objects;

In contrast, the applicant's claimed invention: An adaptive pattern recognition based controller apparatus and method and human-factored interface therefore.

Accordingly, an interference cannot be initiated based upon these claims.

8. Applicant's arguments filed July 2, 2002 have been fully considered but they are not persuasive.

The restriction requirement was made final.

The 35 U.S.C. §112, first paragraph rejection is maintained. The specification passages cited by applicant do not provide support for the invention as claimed. No content related records are presented to the user in the specification. Further, no relation is feedback to the user and no user profile is ever updated. Additionally, the specification does not support any automatic presentation to the user and/or automatically updating a user profile. Admittedly, automatic activity occurs in the specification but not in support of the claimed invention.

The 35 U.S.C. §102(b) rejection is maintained. Yourick stores content records and user profiles. The user profile is updated based on feedback and automatically generates a user

interest profile prior to storing the profile. Customer profiles are likewise maintained for future system reference. Essentially, the applicant argues that Yourick has deficiencies but fails fully distinguish them from their claimed invention. It is alleged that Yourick fails to provide:

- (1) a step or means for storing a plurality of content records;
- (2) a step or means for storing a user profile;
- (3) a step or means for updating the user profile; and
- (4) a step or means for automatically generating a user profile  
representing their interest.

Clearly, Yourick anticipates storing plural content records (tables 1-10), storing a user profile (col. 4, line 64), updating the user profile (col. 9, lines 41-58), automatically generating user profiles on the basis of user interest (col. 5, lines 10+).

The argument asserts that Yourick must disclose storing profiles persistently and have tolerance. This argument is irrelevant because the claimed invention does not encompass this language, and so Yourick is not required to meet this language. Yourick meets the claim language fully which include items (1)-(4) above.

The 35 U.S.C. §103 rejection is maintained for the same reasons as above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Gordon whose telephone number is (703) 305-9760. The examiner can normally be reached on Mondays through Thursdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
PAUL P. GORDON  
PRIMARY EXAMINER

ppg  
October 28, 2002